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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,284	09/14/2000	Ken Hayward	D990171	9833

7590

03/24/2003

John E Beck  
Xerox Corporation  
Xerox Square 20A  
Rochester, NY 14644

EXAMINER

FADOK, MARK A

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 03/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/662,284

Applicant(s)

HAYWARD ET AL.

Examiner

Mark A Fadok

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Appeal Brief***

In view of the appeal brief filed on 01/14/2003, PROSECUTION IS HEREBY REOPENED. New grounds for rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (a) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or
- (b) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

The arguments provided in the appeal brief are considered moot in view of the new grounds of rejection provided below.

### ***Withdrawal of Double Patenting Rejection***

After further review the double patent rejection is removed from consideration. New matter was introduced into the current specification and claims that distinguish the instant application from application #09/397,126. At least the following new matter of "wireless connectivity" and "sending a digital electronic signature" are present.

***Priority***

Because of the new matter being claimed as noted above, priority of the instant application is determined to be the file date of 9/14/2000.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haines (6,233,409), in view of Haines (6295,423), in view of Walker (6,302,527), in view of IDOC's (see attached form PTO 892), and further in view of Official Notice.**

In response to claim 1-21, Haines discloses:

- monitoring electronically a condition of a replaceable part in a first device (FIG 3) the replaceable part having: a first condition upon installation; at least one intermediate condition after use; and a third condition when a replacement part is substantially necessary;
- electronically sending a signal to a second device, the signal automatically electronically offering to purchase a replaceable part upon identification of at least one of the first condition, second condition, and third condition in the replaceable part.; and
- predicting a condition of the part prior to the electronically sending the signal.
- installing the replaceable part prior to occurrence of the third condition.
- providing information relating to the signal to at least one of a

user, a supplier, and a third party.

- the information relates to at least one of: (1) a present condition of the part; (2) a prediction of a future condition of the part; (3) an inquiry; and (4) an offer to purchase.

- at least one of the first device and the second device are interactive.

- sending data to the supplier after a user enters data.

- the information further relates to at least one of: (1) present supply of a consumable; (2) wear of a consumable; (3) usage of the part; (4) rate of depletion of a consumable; (5) rate of wear of the consumable; (5) predicted date of depletion of the consumable; (5) a predicted date of need of a consumable; (6) delivery schedule of a consumable; and (5) statistical data relating to a part. (see at least abstract summary and Fig's 3-5)

Haines however does not teach the following features:

sending a digital electronic signature associated with the offering to purchase the replaceable part. Microsoft Computer dictionary, Fourth addition defines a signature as 1. A sequence of data used for identification, such as text appended to an e-mail message or fax. 2. A unique number built into hardware or software for

authentication purposes. Haines 409 teaches a unique component identifier that is used to identify the component part electronically (col 4, lines 50-65)

receiving electronically an acceptance of the offer to purchase the replaceable part. Haines teaches placing an order automatically through electronic means (see at least summary), but does not specifically teach receiving electronically an acceptance of the offer to purchase the replaceable part. It is old and well known in the art for acceptance of an offer to be confirmed. It would be obvious to a person of ordinary skill in the art to include in Haines 409 an order acceptance because this would confirm the order and reduce the possibility of sending parts that were not needed.

delivering the replaceable part to the first device when monitoring indicates the condition of the part is between about the first condition and the third condition. Haines 409 teaches ordering a part when status monitoring indicates to do so (see at least FIG's 3,4 and 5), but does not specifically mention that the parts will be delivered to the first device. It is old and well known in the art to supply a shipping address when ordering parts. It would have been obvious to a person of ordinary skill in the art to include in Haines a shipping address, because the part would need to be delivered somewhere and delivering the part to the devices location would save handing and time.

using a sensor and software system to perform monitoring and

predicting of a condition of the part. Haines 409, teaches a status monitor 64, which monitors the toner cartridge 32 and receives a trigger event indicating that the orderer should initiate a process to order a new toner cartridge, but does not specifically mention a sensor. Haines 423 teaches an exemplary toner sensor 30 is provided for use with a toner reservoir 31 of printer 10 for detecting the toner level present within reservoir 31. It is to be appreciated that any type of toner sensor can be used in this context, including but not limited to artificial intelligence-based sensors, optical density sensors and capacitive. In addition, although the toner sensor 30 is shown as being incorporated inside the reservoir 31, it is to be understood that it could be located outside of the reservoir as in the case of an optical density sensor or artificial intelligence-based sensor. An example of an artificial intelligence-based sensor is disclosed in U.S. Pat. No. 5,794,094, incorporated by reference above (col 4, lines 36-47). It would be obvious to a person of ordinary skill in the art to include in Haines 409 the sensory devices as taught by Haines 423, because the service described in Haines 409 would require a sensing device of some sort to notify the status monitor that the toner condition is low

displaying a purchase order screen including data relating to the part automatically filled out on the purchase order screen based on an identified condition; and sending the data electronically to a supplier of the part after personal information data is automatically entered by an application program into the purchase order screen. Haines 409, discusses sending information from the supplier and an electronic order col's 1,2 and 3), but does not specifically mention a purchase order screen. It is



old and well known in the art for information sent to a users browser to contain an offer to purchase the part. For example, IDOC's teaches a linked URL that can contain an interactive enterprise application such as an order entry application for consumers. It would be obvious to include the offer to purchase the part through the order entry application to increase the speed and ease of using the system.

the electronically sending of the signal to the second device is a wireless communication. Haines 409 teaches an antenna coil item 50 and radio frequency identification (RFID) along with a RFID memory tag that communicates with the interrogator (col 3 and 4), but does not specifically mention the word wireless. Walker teaches a wireless link that is connected to a sensor for sensing status of the replaceable printing component (col 1, line 63 through col 2, line 29). It would be obvious to a person of ordinary skill in the art to include in Haines 409 the wireless connection as taught by Walker, because adding a wireless connection would provide portability to the printer and would also be more adaptable because a hardwire would not need to be present in the printer for the system to operate.

### ***Response to Arguments***

Applicant's arguments with respect to claim 1-21 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Friday 8:00 AM to 4:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

**(703) 305-7687** [Official communications; including

After Final communications labeled

"Box AF"]

**(703) 746-7206** [Informal/Draft communications, labeled


"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.



Mark Fadok

Patent Examiner



**WYNN W. COGGINS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**